

Appln. No. 10/082,774
Amendment dated February 27, 2006
Reply to Office Action of November 25, 2005
Docket No. BOC9-2001-0002 (238)

REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of November 25, 2005 (Office Action). As this response is timely filed within the three-month shortened statutory period, no fee is believed due.

In paragraph 1 of the Office Action, Claims 1, 2, 4-12, and 14-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Patent Application No. 2002/0061099 to Hayashi, *et al.* (hereinafter "Hayashi"). In paragraph 2 of the Office Action, Claims 3 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi in view of U.S. Patent No. 6,631,186 to Adams, *et al.* (hereinafter "Adams").

Applicants' Invention Predates Hayashi

At pages 2-3 of the Office Action, it is asserted that Applicants have failed to establish their diligence from a date prior to the effective date of Hayashi to the date of a constructive or actual reduction to practice of the invention. Specifically, it is stated that "[b]ecause facts regarding the diligence of the [Applicants] during the two above-mentioned gaps have not been presented in [the] form of either evidence or allegation of fact in a declaration, the [earlier-presented] Declarations under 37 C.F.R. § 1.131 are ineffective."

Applicants respectfully point out that they have thus far presented not only their own Declarations but factual evidence of actual dates and activities during the entire period necessary to establish that Applicants' invention predates the effective date of Hayashi (November 15, 2001). Indeed, Applicants respectfully submit that the very fact that the "two above-mentioned gaps" are of such extraordinarily short duration is itself evidence of how extensive and encompassing Applicants' accounting of this period has been to date: the first of the two gaps is a two-week period from 25 January 2002 to 8

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February 2002; the second is a mere one-week period from 18 February 2002 and the date of reduction to practice. Gaps of "such short duration" are usually part of the "inevitable minor interruptions accompanying the conduct of patent prosecution" and easily fall "within the limits of reasonable diligence." *Sletzinger v. Lincoln*, 410 F.2d 808, 812-13 (CCPA 1969) More fundamentally, the standard of diligence has never required "evidence of activity on every single day." See *Monsanto Co. v. Mycogen Plant Science, Inc.*, 261 F.3d 1356, 1369 (Fed. Cir. 2001). All that is required is an explanation evincing that Applicants "were doing the things reasonably necessary to reduce the idea to practice . . . , even if they did not actually work on the invention each day." *Hybritech, Inc. v. Abbott Laboratories*, 4 USPQ2d 1001, 1006 (C.D. Calif. 1987), *aff'd*, 849 F.2d 1446 (Fed. Cir. 1988).

Applicants present herein their Declarations addressing the two "gaps" asserted to exist in the record. During the first, from 25 January 2002 to 8 February 2002, Applicants were waiting to receive a completed draft of the patent application from outside counsel. As already established and as reiterated in the presently-presented Declarations, the draft was sent by First Class Mail on January 25, 2002. Accordingly, at least some of this period is accounted for the inevitable time necessary for the draft to reach the inventors through the mail system. After the draft was received by the Applicants in their respective cities (one inventor was in Florida and two inventors were in Texas), they began the process of reviewing the draft and consulting with one another on any needed revisions. Applicants respectfully assert that the very fact that the process was completed as quickly as it was evinces considerable diligence, not a lack thereof.

In this latter context, it must be remembered that not only was there the inevitable time lag between the sending of the draft and Applicants' receipt thereof by mail, but Applicants also had other projects related to their employment that required their attention. This fact is important to consider because long-established judicial precedent recognizes that in most instances an inventor has additional responsibilities to his or her

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employer. If the patent laws were to place an inventor in a position of having to choose between a hyperactive pursuit of an invention and meeting other obligations, the creative process the law is intended to promote would be harmed rather than fostered.

As the courts have repeatedly emphasized, an inventor need not surrender or neglect his regular employment in order to show reasonable diligence in working toward reduction to practice. "Proof of reasonable diligence . . . does not require a party to work constantly on the invention or to drop all other work" *Mycogen Plant Science, Inc. v. Monsanto Co.*, 252 F.3d 1306, 1316 (Fed. Cir. 2001); *see also Courson v. O'Connor*, 227 F. 890, 894 (7th Cir. 1919) ("The exercise of reasonable diligence does not require an inventor to devote his entire time thereto."); *Gould v. Schallow*, 363 F.2d 908, 919 (CCPA 1966) ("reasonable diligence does not require that one abandon his means of livelihood to further his reduction to practice."); and *Harper v. Zimmerman*, 41 F.2d 261, 268 (D. Del. 1930) ("[t]he law does not require that the inventor give all his time to development of the invention or abandon his usual occupation or means of livelihood.")

During the second "gap" asserted in the Office Action to exist for the one-week period from 18 February 2002 and the date of reduction to practice, Applicants, as stated in the presently-presented Declarations, were primarily relying on outside counsel to incorporate suggested revisions in the draft sent earlier by mail to Applicants, while also making themselves available to provide any supplemental information needed to clarify the suggested revisions. Again, the shortness of this period hardly evinces lack of attention, but rather considerable diligence on the parts of both Applicants and their outside counsel. *See, e.g., Gould v. Schallow*, 363 F.2d 908, 916 (CCPA 1966); *see also Rines v. Morgan*, 250 F.2d 365, 369 (CCPA 1957) ("it is not necessary that an inventor or his attorney should drop all other work and concentrate on the particular invention involved.").

Applicants respectfully submit that the Declarations and factual evidence of actual activity on dates certain presented clearly establish that Applicants were doing all things

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"reasonably necessary to reduce the idea to practice" from a date prior to the effective date of Hayashi to the date of constructive reduction to practice of the invention. Applicants, therefore, respectfully maintain that because Applicants conceived of the present invention before the effective date of Hayashi, and exercised due diligence from a time prior to the effective date to the filing date, Hayashi should be withdrawn as a reference for purposes of 35 U.S.C. § 102(e). Given that the rejection of each claim is based upon Hayashi or a combination including Hayashi, the withdrawal of Hayashi establishes that the prior art provides no basis for rejecting claims 1-20. Accordingly, Applicants respectfully request that the rejections of Claims 1-20 be withdrawn.

Respectfully submitted,

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